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Paper 160
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UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

ELAZAR RABBANI, JANNIS G. STAVRIANOPOULOS,
JAMES J. DONEGAN, JACK COLEMAN and MARLEEN WALNER,

Junior Party
(Application 10/306,990),

v.

TSUGUNORI NOTOMI and TETSU HASE,

Senior Party
(Patent 6,410,278 B1)
(Patent 6,974,670 B2).

Patent Interference 105,427—McK
Patent Interference 105,432—McK
Technology Center 1600

*Before: FRED E. McKELVEY, Senior Administrative Patent Judge, and
RICHARD TORCZON and JAMES T. MOORE, Administrative Patent
Judges.*

McKELVEY, Senior Administrative Patent Judge.

MEMORANDUM OPINION and ORDER
Decision on priority

A. Statement of the case

The interference is before a merits panel for a decision on priority and
consideration of other pending requests and deferred motions.

1 Rabbani motion 4

2 Rabbani Motion 4 seeks judgment based on priority. Paper 133.

3 Notomi Opposition 4 was timely filed. Paper 135.

4 Rabbani Reply 4 was timely filed. Paper 138.

5 Rabbani Motion 4 is *denied*.

6 Rabbani Request for Rehearing

7 Rabbani has requested rehearing of a decision (Paper 145) denying
8 Rabbani Motion 5 (Paper 139). Paper 148.

9 Notomi was invited via email to file an opposition (Paper 154, page 2)
10 and has timely filed an opposition. Paper 154.

11 The Rabbani request for rehearing is *dismissed* as moot.

12 Rabbani Motion 1

13 Rabbani Motion 1 seeks to have Notomi claims not involved in the
14 interference designated as corresponding to the counts. Paper 47.

15 Notomi did not file an opposition.

16 Rabbani Motion 1 was deferred to the priority phase. Paper 57.

17 Rabbani Motion 1 is *dismissed* as moot.

18 Rabbani Motion 2

19 Rabbani Motion 2 seeks to combine the subject matter of Count 1 and
20 Count 2 into a single Count 3. Paper 54.

21 Notomi Opposition 2 was timely filed. Paper 69.

22 Rabbani Reply 2 was timely filed. Paper 78.

23 Rabbani Motion 2 was deferred to the priority phase. Paper 118,
24 page 46.

25 Rabbani Motion 2 is *dismissed* as moot.

1 Notomi Motion 6

2 Notomi Motion 6 seeks judgment based on priority. Paper 134.

3 The motion is based solely on Rabbani's failure to establish priority
4 and not on Notomi having established a date of invention prior to any date of
5 invention alleged in the Rabbani Motion 4.

6 We view the motion as a *pro forma* motion.

7 The parties apparent viewed the motion in the same way because there
8 was no Rabbani opposition and therefore no Notomi reply.

9 Notomi Motion 6 stands or falls with Rabbani Motion 4.

10 Notomi Motion 6 is *granted*.

11 Notomi Motion to Exclude

12 Notomi Motion to Exclude seeks to exclude evidence offered by
13 Rabbani during the motions phase. Paper 95.

14 The Notomi motion is not numbered in accordance with the usual
15 practice in interference cases.

16 Rabbani timely opposed. Paper 100.

17 Notomi timely replied. Paper 105.

18 Notomi Motion to Exclude was dismissed-in-part and deferred-in-part
19 by a motions panel (Judges McKelvey, Hanlon and Spiegel); deferral was to
20 the priority phase. Paper 118, page 47-48.

21 Notomi Motion to Exclude, to the extent it was deferred, is *dismissed*
22 as moot.

23 Notomi Motion 3

24 Notomi Motion 3 seeks to exclude evidence offered by Rabbani
25 during the priority phase. Paper 142.

26 Rabbani Opposition 3 was timely filed. Paper 146.

27 Notomi Reply 3 was timely filed. Paper 149.

1 Notomi Motion 3 is *granted-in-part* and *dismissed-in-part* (dismissal
2 being based on mootness).

3 The interferences

4 Information relevant to the parties, the real parties in interference, the
5 counts, and the claims corresponding to the counts is set out in the motions
6 panel's opinion in support of its decision on substantive motions. Paper 118,
7 page 3, Finding 1 through page 5, Finding 22.

8 In addition to the information presented in Paper 118, we add the
9 following.

10 I.

11 Count 1 (Notomi claim 11) in Interference 105,427 was suggested by
12 Rabbani when it sought an interference with Notomi patent 6,410,278 B1.
13 Paper 4, page 1:49-50.

14 The suggestion was adopted. Paper 4, page 1:51.

15 During the interference, Rabbani made no attempt to change the scope
16 of Count 1.

17 II.

18 In suggesting an interference with Notomi patent 6,974,670 B2,
19 Rabbani suggested that the count be Rabbani claim 216. Paper 4,
20 page 2:24-25.

21 The suggestion was not adopted. Paper 4, page 2:26.

22 In suggesting the interference, Rabbani conceded that claim 1 of
23 Notomi patent 6,974,670 B2 had a "wherein" limitation not present in
24 Rabbani claim 216. Paper 4, page 3:1-4.

25 Rabbani's position was that the "wherein" limitation was not
26 significant because it is allegedly inherent. Paper 4, page 3:5-7.

1 Notomi claim 1 having the "wherein" limitation was selected as the
2 count.

3 During the interference, Rabbani made no attempt to have a count
4 using the language of Rabbani claim 216 substituted for Count 2.

5 Rabbani was apparently content to have the interference resolved on
6 the basis of Count 2, subject to Rabbani Motion 2—discussed in more detail
7 *infra*—to have Count 1 and Count 2 combined into a single count.

8 III.

9 When the interferences were declared, Rabbani was made senior party
10 because *initially* Rabbani was accorded earlier constructive reductions to
11 practice based on two earlier filed Rabbani applications (referred to later in
12 this opinion as Rabbani "parent" application and Rabbani "grandparent"
13 application). Interference 105,427, Paper 1, page 10; Interference 105,432,
14 Paper 1, page 11.

15 Rabbani's accorded date of invention was prior to the earliest date
16 accorded to Notomi.

17 As a result of the granting of Notomi Motions 2, 3 and 4, (1) Notomi
18 was accorded benefit of an International application (PCT application) and a
19 Japanese patent application and (2) benefit initially accorded to Rabbani
20 when the interferences were declared as "taken away."

21 As a result, the date of invention accorded to Notomi was prior to the
22 date of invention accorded to Rabbani and therefore Notomi became
23 "senior" party.

24 The "senior" party is presumed to be the first inventor and therefore
25 Rabbani had the burden on the issue of priority. 37 C.F.R. § 41.207(a)(1)
26 (2007) [Bd. R. 207(a)(1)].

1 **B. Findings on priority**

2 At oral argument, Notomi appeared to suggest that in Interference
3 105,427, Rabbani may be under a burden to prove priority by clear and
4 convincing evidence. Oral argument transcript, page 35:6-8.

5 Why? Because, Rabbani's involved application was filed on
6 29 November 2002 after involved Notomi Patent 6,410,278 B1 issued on
7 25 June 2002. *See* 37 C.F.R. § 41.207(a)(2) (2007) [Bd. R. 207(a)(2)],
8 codifying *Price v. Symsek*, 988 F.2d 1187 (Fed. Cir. 1993) (where
9 application filed after patent issues, burden of proving priority by junior
10 party is by clear and convincing evidence).

11 Bd. R. 207(a)(2) provides that a party must prove priority by clear
12 and convincing evidence if the date of its earliest constructive reduction to
13 practice is after the issue date of the involved patent.

14 However, we do not think the burden of proof standard is a real issue
15 in this case.

16 We resolve the issue of priority on the basis that Rabbani suppressed
17 or concealed its alleged actual reduction to practice.

18 The facts related to suppression or concealment are in large measure
19 undisputed.

20 On the issue of suppression and concealment we do not believe it
21 makes any difference whether the standard of proof is by a preponderance of
22 the evidence or by clear and convincing evidence.

23 The following findings of fact are believed to be supported under
24 either a preponderance of the evidence or by clear and convincing evidence.

25 To the extent that a finding of fact is a conclusion of law, it may be
26 treated as such.

1 Additional findings as necessary may appear in other portions of the
2 opinion.

3 Rabbani actual reduction to practice

4 Rabbani alleges that it actually reduced to practice on 04 February
5 1998. Rabbani Motion 4, Paper 133, page 20:19-20. *See also* Notomi Fact
6 136 which is admitted by Rabbani. Paper 138, page 49:3-5.

7 Notomi disputes that Rabbani has established an actual reduction to
8 practice. Notomi Opposition 4, Paper 135.

9 However, because suppression or concealment has been established
10 on this record, we—like the Federal Circuit in *Lutzker v. Plet*, 843 F.2d 1364
11 (Fed. Cir. 1988), and the Board in *Morrison v. Lakes*, 63 USPQ2d 1742 (Bd.
12 Pat. Int. & Int. 2002)—will assume for the purpose of this decision that
13 Rabbani actually reduced to practice no later than 04 February 1998.

14 Rabbani's filing date

15 Rabbani filed its involved application on 29 November 2002.

16 Accordingly, Rabbani's date of invention is 29 November 2002,
17 unless it can establish an earlier date of invention.

18 Time between actual reduction to practice and filing application

19 Rabbani's 29 November 2002 filing date is 4 years, 8 months and
20 25 days (nearly 57 months) after its alleged actual reduction to practice.
21 Notomi Fact 140 which is admitted by Rabbani. Paper 138, page 49:20-23.

1 Activity toward making Rabbani invention public

2 Rabbani has not established that its assignee (Enzo) used or sold
3 embodiments of the invention of Counts 1 and 2 prior to the filing date of
4 the involved Rabbani application. Notomi Facts 141-144, Paper 138,
5 page 49:25 through page 50:11—all admitted by Rabbani. *See* also Oral
6 argument transcript, page 36:2-7

7 Rabbani has not established that its assignee commercially exploited
8 the inventions of Counts 1 and 2 prior to the filing date of the involved
9 Rabbani application. Notomi Facts 145-148, Paper 138, page 50:13-27—all
10 admitted by Rabbani.

11 The motions panel determined that Rabbani "parent" application
12 09/439,594 filed 12 November 1999 [now U.S. patent 6,764,821] does not
13 describe an embodiment within the scope of Count 1 or Count 2 and,
14 therefore, does not constitute a constructive reduction to practice of the
15 inventions of Count 1 or Count 2.

16 The motions panel determined that Rabbani "grandparent" application
17 09/104,067, filed 24 June 1998 [now U.S. patent 6,743,605] does not
18 describe an embodiment within the scope of Count 1 or Count 2 and,
19 therefore, does not constitute a constructive reduction to practice of the
20 inventions of Count 1 or Count 2.

21 Rabbani did not make the inventions defined by Count 1 and Count 2
22 accessible to "the public" by filing either the Rabbani "parent" application or
23 the Rabbani "grandparent" application.

24 The Fedus testimony

25 Ronald C. Fedus is corporation and patent counsel of Rabbani's real
26 party in interference—Enzo Biochem, Inc. Ex 1076, ¶ 2.

1 Mr. Fedus has been corporation and patent counsel since February
2 1990. Ex 1076, ¶ 2.

3 Mr. Fedus testified that the "[i]nventive subject matter associated with
4 the isothermal amplification invention disclosed in the ... [Rabbani "parent"
5 application] and the ... [Rabbani "grandparent" application] ... was not
6 abandoned, concealed or suppressed, and has continued to be prosecuted in
7 the patent applications filed in both the United States Patent and Trademark
8 Office ("USPTO") as well as national patent offices in foreign jurisdictions."
9 Ex 1076, ¶ 13.

10 According to Mr. Fedus, examples of patent applications filed in the
11 USPTO directed to inventive subject matter associated with the isothermal
12 amplification invention disclosed in the Rabbani "parent" application
13 include the following:"

- 14 1. Application 10/307,108 (27 November 2002).
- 15 2. Application 10/304,035 (22 November 2002).
- 16 3. Application 10/305,690 (27 November 2002).
- 17 4. Application 10/302,362 (22 November 2002).
- 18 5. Application 10/305,664 (27 November 2002).
- 19 6. Application 10/303,152 (22 November 2002).

20 Ex 1076, ¶ 14.

21 We will assume that the applications are owned by Enzo.

22 These applications were filed either 2 days before or 7 days before the
23 involved Rabbani application, which was filed on 29 November 2002.

24 How filings 2 or 7 days prior to the filing of the involved Rabbani
25 application have any significant bearing on the issue of suppression or
26 concealment over a 57 month period escapes us.

1 Further according to Mr. Fedus, examples of patent applications filed
2 in the national patent offices in foreign jurisdictions, "directed to inventive
3 subject matter associated with the isothermal amplification invention
4 disclosed in the ... [Rabbani "parent" application] include, but are not
5 limited to the following:"

6 *In the Japanese Patent Office:*

- 7 1. JP application 19990179056 (24 June 1999).
8 2. JP application 20030428482 (24 December 2003).
9 3. JP 20050120409 (18 April 2005).

10 *In the European Patent Office:*

- 11 4. EP application 19990112181 (24 June 1999).

12 *In the Israeli Patent Office:*

- 13 5. Israeli application 19990120477 (14 June 1999).

14 *In the Canadian Patent Office:*

- 15 6. Canadian application 19992475018 (15 June 1999).
16 7. Canadian application 19992273064 (15 June 1999).

17 Ex 1076, ¶ 15.

18 JP application 20030428482 (24 December 2003) and JP application
19 20050120409 (18 April 2005) were filed *after* the involved Rabbani
20 application was filed and therefore their relevance to the suppression or
21 concealment issue before us is not apparent.

22 Rabbani has not placed in evidence copies of the applications that
23 were mentioned by Mr. Fedus.

24 Mr. Fedus made no attempt to explain how the subject matter of
25 Count 1 or Count 2 is described in any of the above-mentioned applications.

1 Rabbani has failed to establish through the testimony of Mr. Fedus or
2 otherwise that Enzo attempted to make the invention accessible to the public
3 by filing any of these domestic or foreign patent applications.

4 There is additional testimony by Mr. Fedus.

5 According to Mr. Fedus, Enzo did not have any intention of
6 abandoning, suppressing or concealing "the inventions disclosed and
7 claimed in the U.S. or foreign application including ... [the inventions]
8 disclosed in the ... [Rabbani "parent" application] and [Rabbani
9 "grandparent" application]." Ex 1076, ¶ 16.

10 Further according to Mr. Fedus, Enzo did not have any intention of
11 suppressing or concealing any of the invention disclosed and claimed in any
12 of the U.S. or foreign applications. Ex 1076, ¶ 17.

13 We decline to credit the Fedus testimony.

14 To the extent that Mr. Fedus relies on inventions asserted to have been
15 disclosed in domestic and foreign applications, he did not testify or
16 otherwise explain how the inventions of Count 1 and Count 2 are described
17 in those applications.

18 To the extent that Mr. Fedus alleged that Enzo did not intend to
19 suppress or conceal "inventions," he is (1) a witness employed by Enzo
20 (2) with an interest in having the Board arrive at a particular result and
21 (3) the basis for his allegations are not supported by cogent explanations of
22 documents in the record.

23 While Rabbani hints that the Fedus testimony was not cross-examined
24 and therefore should be accepted, we fully appreciate why Notomi elected to
25 conserve financial and litigation resources by electing to not cross-examine
26 Mr. Fedus: there simply was no need to do so.

1 Suppression or concealment

2 When viewed as a factual matter, the evidence supports an inference
3 that Rabbani and Enzo suppressed or concealed its assumed actual
4 reductions to practice of the invention from the public by waiting "too long"
5 to file the involved Rabbani application.

6 The "too long" language comes from the Federal Circuit's decision in
7 *Paulik v. Rizkalla*, 760 F.2d 1270, 1275 (Fed. Cir. 1985) (*en banc*).

8 **C. Discussion relevant to priority**

9 I.

10 A.

11 The legal principles controlling the suppression or concealment
12 analysis are well-established.

13 Relevant considerations appear in (1) Parts II through IV of *Paulik v.*
14 *Rizkalla, supra*, 760 F.2d at 1272-1275, (2) *Morrison v. Lakes*, 63 USPQ2d
15 1742 (Bd. Pat. App. & Int. 2002) and (3) *Kundu v. Ragunathan*, 73 USPQ2d
16 1180 (Bd. Pat. App. & Int. 2002).

17 Whether an invention has been suppressed or concealed within the
18 meaning of 35 U.S.C. § 102(g)(1) is a question of law. *Fujikawa v.*
19 *Wattanasin*, 93 F.3d 1559, 1567 (Fed. Cir. 1996).

20 B.

21 The time period between the assumed actual reduction to practice on
22 04 February 1998 and the date the involved Rabbani application was filed is
23 about 57 months.

24 What relevant activity took place at Enzo during those 57 months to
25 make the invention accessible to public? So far as we can tell: "Nothing."

26 Under established legal principles, Notomi bears the burden of proof
27 on suppression or concealment even though it is the senior party.

1 However, recognizing that virtually all of the evidence of activity to
2 make the Rabbani invention accessible to the public is in the hands of Enzo
3 (not Notomi), Notomi justifiably relied on the priority case put on by
4 Rabbani to support its position on suppression or concealment.

5 The 57-month period in this *interference* case is similar to or longer
6 than time periods in prior cases where suppression or concealment was held
7 to exist: (1) a 23-25 time period in *Palmer v. Dudzik*, 481 F.2d 1377 (CCPA
8 1973); (2) a 27-28 time period in *Young v. Dworkin*, 489 F.2d 1277 (CCPA
9 1974); (3) a 4 year time period in *Peeler v. Miller*, 535 F.2d 647 (CCPA
10 1976); (4) a 2 year, 5 month time period in *Shildelar v. Holdeman*, 628 F.2d
11 1337 (CCPA 1980); and (5) a 51 month time period in *Lutzker v. Plet*, 843
12 F.2d 1364 (Fed. Cir. 1988).

13 The 5 year, 6 month suppression and concealment time period in
14 *Horwath v. Lee*, 564 F.2d 948 (CCPA 1977) (suppressed) is longer than
15 Rabbani's 57-month period.

16 Rabbani calls our attention to *Fujikawa v. Wattanasin*, 93 F.3d 1559
17 (Fed. Cir. 1996) (not suppressed), where a 17-month time period was held
18 not to constitute suppression or concealment. Paper 138, page 12.

19 Rabbani's 57-month time period is considerably longer than the
20 17-month time period in *Fujikawa v. Wattanasin*.

21 In addition, Rabbani has not shown that it engaged in the kind of
22 activities which the Federal Circuit held negated an inference of suppression
23 or concealment in *Fujikawa v. Wattanasin*.

24 In Rabbani Motion 4, two *non-interference* cases are called to our
25 attention. Paper 133, page 20: *Dow Chemical Co. v. Astro-Valcour, Inc.*,
26 267 F.3d 1334, 1342 (Fed. Cir. 2001), and *Checkpoint Systems, Inc. v. U.S.*
27 *Int'l Trade Comm'n*, 54 F.3d 756, 761 (Fed. Cir. 1995).

1 *Dow* and *Checkpoint* do not involve competing inventors seeking a
2 patent.

3 In *Dow*, it was held that during a 30-month period between first
4 making isobutene-blown foam and selling the foam, AVI actively and
5 continuously took steps toward the commercialization of the foam, including
6 procurement of financing to build a new production plant and attention to
7 safety considerations associated with using isobutene as a blowing agent.

8 Because the undisputed evidence showed that AVI made reasonable
9 efforts toward commercialization, Dow was unable to show that AVI
10 suppressed or concealed the invention. 267 F.3d at 1342-43.

11 In *Checkpoint*, the Federal Circuit indicated that one way a prior
12 inventor may avoid suppression and concealment under 102(g) is to file a
13 patent application claiming the invention. 54 F.3d at 761.

14 Section 102(g) has been held to be applicable in other contexts as
15 well, such as when prior invention is asserted as a basis for invalidating a
16 patent as a defense to an infringement suit. *Id.* at 762:

17 In such a case, a first inventor may seek to avoid a determination of
18 suppression or concealment by showing that it marketed or sold a
19 commercial embodiment of the invention or described the invention in a
20 publicly disseminated document.

21 In cases in which an invention is disclosed to the public by
22 commercialization, courts have excused delay upon proof that the first
23 inventor engaged in reasonable efforts to bring the invention to market. *Id.*

24 *Dow* and *Checkpoint* provide little, if any, comfort to Rabbani,
25 because Rabbani and Enzo have not shown that any attempt was made to
26 commercialize the suppressed or concealed actual reduction to practice.

1 Enzo, through its patent counsel, admits that it did not attempt to
2 commercially exploit the inventions of Count 1 or Count 2 or otherwise
3 attempt to make the inventions accessible to the public.

4 While Mr. Fedus alleges that an invention was described in certain
5 domestic and foreign patent applications, he failed to tell us precisely what
6 the invention was and how the invention is described in those applications.

7 *Although it could have*, Rabbani did not offer the relevant patent
8 applications in evidence.

9 On this basis, we find that Notomi has established that, consistent
10 with Federal Circuit and Board precedent, it is reasonable to infer that
11 Rabbani and Enzo suppressed and concealed its alleged actual reduction to
12 practice.

13 Rabbani and Enzo have failed to offer credible "story" to overcome
14 the inference.

15 We are left, then, with an unrebutted inference of suppression or
16 concealment.

17 Accordingly, as a matter of law the inventions said to have been
18 actually reduced to practice by Rabbani on 04 February 1998, was
19 suppressed or concealed within the meaning of 35 U.S.C. § 102(g)(1).

20 C.

21 In presenting its suppression or concealment argument, Notomi talks
22 in terms of a presumption existing when an invention is not made accessible
23 to the public "too long" after an actual reduction to practice.

24 We are not comfortable using "presumptions" in the suppression and
25 concealment analysis.

We think the better approach is to consider the length of time, and if it is "too long," then an inference can be drawn that an actual reduction to practice has been suppressed or concealed.

Whether a period of time is "too long" depends on the facts of each case.

The length of time and any rebuttal evidence, when considered as a whole, form the basis for concluding, as a matter of law, whether suppression or concealment took place within the meaning of 35 U.S.C. § 102(g)(1).

II.

A.

The suppression and concealment issue in this interference was first raised by Notomi when it was served with Rabbani's case-in-chief.

Notomi objected to the admissibility of the evidence offered by Rabbani in support of its 04 February 1998 assumed actual reduction to practice. Ex 2038.

B.

The procedure applicable to interferences for objecting to admissibility of evidence is a two-step process.

1.

A case-in-chief in an interference consists of (1) a motion (including an explanation of the basis for relief requested in the motion) and (2) the evidence in support of the motion.

A case-in-chief in an interference rarely relies on deposition evidence, because most of the time all the evidence presented is in the possession and under the control of the inventor or the real party in interest.

1 Consistent with the normal expectation, Rabbani served a case-in-
2 chief which did not rely on deposition evidence.

3 After the Rabbani case-in-chief was served, Notomi had 5 days to
4 object to the admissibility of any evidence relied upon by Rabbani.
5 37 C.F.R. § 41.155(b)(1) (2007).

6 The Federal Rules of Evidence govern admissibility of evidence.
7 37 C.F.R. § 41.152(a) (2007).

8 Notomi timely filed objections. Ex 2038.

9 Notomi's objection, consistent with the holding in *Paulik v. Rizkalla*,
10 *supra*, was that any evidence of an actual reduction to practice relied upon
11 by Rabbani prior to the time it ceased to suppress or conceal should "be
12 disregarded." Ex 2038, page 3:8.

13 In effect, Notomi's objection is based on a lack of relevance under
14 Fed. R. Evid. 402.

15 After objections are filed, the moving party has an opportunity to
16 supplement the original evidence with additional evidence in an attempt to
17 overcome the objection. 37 C.F.R. § 41.155(b)(2) (2007).

18 Additional evidence is submitted prior to the time an opponent has to
19 file an opposition, thereby giving the opponent an opportunity—if it be so
20 advised—to cross examine.

21 Insofar as we can tell, Rabbani made no attempt to supplement its
22 evidence in direct response to Notomi's objection (Ex 2038).

23 In fact, it appears that Rabbani offered "pre-emptive" evidence on the
24 issue of suppression and concealment; for example the Fedus testimony
25 (Ex 1076) served with Rabbani's case-in-chief.

2.

If the opponent remains of the view that the evidence is inadmissible, and wishes to pursue the objection before the Board, then in the priority phase during Time Period 15, the opponent may file a motion to exclude the evidence to which a previous objection was made under Bd.R. 155(b)(1). 37 C.F.R. § 155(c) (2007).

Consistent with Bd.R. 155(c), Notomi filed a motion to exclude. Notomi Motion 3, Paper 142.

In effect, Notomi has renewed the objection (Ex 2038) to the admissibility of Rabbani's priority case-in-chief based on Rabbani having suppressed or concealed its actual reduction to practice.

C.

One Rabbani response to Notomi Motion 3, as well as to Notomi's suppression and concealment argument on the merits in Notomi Opposition 4, is that there was no suppression or concealment because the inventions of Count 1 and Count 2 are described in the Rabbini "parent" application and the Rabbini "grandparent" application.

1.

Rabbani's response fails to come to grips with the fact that the motions panel held that neither the Rabbini "parent" application nor the Rabbini "grandparent" application constitute a constructive reduction to practice of the counts.

Accordingly, filing those two applications cannot be considered a meaningful attempt on the part of Rabbini or Enzo to make the inventions of Count 1 or Count 2 accessible to the public.

1 We will observe that had Notomi Motion 2 and Notomi Motion 4
2 been denied (removing benefit accorded to Rabbani), Rabbani would have
3 prevailed on the issue of priority.

4 2.

5 Rabbani maintains that the motions panel's decision is internally
6 inconsistent: Rabbani asks: How can Rabbani describe the invention in its
7 involved Rabbani application and not in its "parent" and "grandparent"
8 application when the disclosures of the involved, "parent" and "grandparent"
9 applications are for all practical purposes the same? Oral argument
10 transcript, page 5:14-page 7:24.

11 Based on this argument, Rabbani reasons that the filing of the
12 Rabbani "grandparent" application has to be considered an attempt to
13 disclose the invention of the counts to the public.

14 Rabbani further reasons that since only 5 months passed from the
15 04 February 1998 assumed actual reduction to practice until the 01 June
16 1998 filing of the Rabbani "grandparent" application, there can be no
17 suppression or concealment. Paper 138, page 12. *See, e.g., Correge v.*
18 *Murphy*, 705 F.2d 1326 (CCPA 1983) (7-month time period was held not to
19 constitute suppression or concealment).

20 However, counsel for Rabbani conceded—as he had to—that Rabbani
21 claim 216 (the only Rabbani claim involved in the interferences) *differs* from
22 Count 1 or Count 2. Oral argument transcript, page 6:4-11.

23 Notomi Motion 1 sought judgment on the ground that Rabbani claim
24 216 was unpatentable for failure to comply with the written description
25 requirement of 35 U.S.C. § 112.

26 Notomi also filed Notomi Motion 2 and Notomi Motion 4 seeking
27 entry of an order denying Rabbani a constructive reduction to practice of the

1 subject matter of the counts based on either the Rabbani "parent" application
2 or the Rabbani "grandparent" application.

3 Since the counts and Rabbani claim 216 differ, it follows that
4 (1) Rabbani may describe the invention of Rabbani claim 216 in its involved
5 application and (2) the Rabbani "parent" application and Rabbani
6 "grandparent" application may not describe the subject matter of the counts.

7 There is no inherent inconsistency in a decision to denying Notomi
8 Motion 1 and granting Notomi Motion 2 and Notomi Motion 4.

9 3.

10 At oral argument, counsel for Rabbani made reference to Rabbani
11 claims which were cancelled at the time the interferences were declared.
12 Oral argument transcript, page 18:27-page 19:3.

13 An observation on the counts, Rabbani claim 216 and the cancelled
14 Rabbani claims may be helpful to the reader.

15 When the interference was declared, and although requested to do so,
16 the Board declined to designate then Rabbani claims 146-147, 150-163,
17 171-215 and 269-274 as corresponding to the count.

18 Instead, only Rabbani claim 216 was designated as corresponding to
19 the counts.

20 The remaining Rabbani claims were cancelled as being unnecessary.
21 Paper 6, page 4:23-24.

22 Why? Because, Rabbani urged and conceded that the claims define
23 the same invention as Rabbani claim 216. Paper 6, page 2:15-18.

24 Claim 216 was deemed sufficient to determine priority. Paper 6,
25 page 3:17-18.

1 Rabbani was notified that in the event it does not prevail on priority,
2 the patentability of those claims would be governed by the judgment rule.
3 Paper 6, page 5:4-13. 37 C.F.R. § 41.127(a) (2007).

4 Cancellation of the claims was without prejudice to Rabbani re-
5 presenting the claims in the event it prevailed on priority.

6 During the motions phase, Rabbani did not take issue with the actions
7 taken in Paper 6 or otherwise request relief from the action taken in Paper 6.

8 Neither the cancellation of those claims nor the decision declining to
9 designate those claims as corresponding to a count in these interferences are
10 issues at this stage of the interference.

11 III.

12 A.

13 In presenting Rabbani Motion 4 for judgment based on priority,
14 Rabbani maintains that it "had performed all of the steps that inherently form
15 the third loop ..." Paper 138, page 9 n.1.

16 Rabbani asserts that by virtue of certain Donegan notebook entries on
17 10 June 1998, Dr. Donegan illustrated the mechanism of the isothermal
18 amplification carried out on 04 February 1998. Paper 138, page 9:10-21.

19 Notomi disputes the factual accuracy of the assertion.

20 In Rabbani's view, the motions panel erred when it held that the
21 Rabbani "parent" application and the Rabbani "grandparent" application do
22 not a constructive reduction to practice of the counts.

23 There are reasons why Rabbani's argument does not go where
24 Rabbani wants it to go.

25 1.

26 An interference is, and has essentially always been, a *two* phase
27 process.

The overall object of an interference is to determine among competing inventors who is the first inventor of the interfering subject matter, *i.e.*, priority of invention.

2.

In the first phase of the interference, known as a *motions phase*, one significant object is to determine the proper scope of the count.

Why? Because priority proofs must fall within the scope of the count. *See* 37 C.F.R. § 41.201 (2007) (definition of "count"), codifying holdings in cases, such as, *Squires v. Corbett*, 560 F.2d 424, 433 (CCPA 1977), and *Fang v. Pischel*, 55 USPQ2d 1383 (Bd. Pat. App. & Int. 2000).

There is no doctrine of equivalents when presenting priority proofs. *Eaton v. Evans*, 204 F.3d 1094, 1097-98 (Fed. Cir. 2000) (in an interference, "there can be no actual reduction to practice if the constructed embodiment or performed process lacks an element recited in the count or uses an equivalent *** because the doctrine of equivalents does not pertain to an interference")

Either the proofs are within the scope of the count or they are not.

So, being sure that the count is correct is a desirable objective of the motions phase.

The parties may ask for leave, and be authorized, to file a motion to change the scope of the count.

After the motions phase is complete, the scope of the count becomes fixed during the second phase of the interference, known as the *priority phase*.

Failure of a party to seek authorization to file a motion to change the count constitutes a waiver for any subsequent attempt to change the count or urge proofs outside the scope of the count.

1 In this case, *while it had an opportunity to do so*, Rabbani did not
2 seek to change the count in Interference 105,432 from Count 2 to Rabbani
3 claim 216.

4 3.

5 Another significant aspect of the motions phase is to determine the
6 dates of invention which should be accorded to the parties.

7 A party may be accorded an earlier constructive reduction to practice
8 vis-à-vis that accorded to the party when the interference is initiated.

9 In this case, the granting of Notomi Motion 3 is illustrative of a
10 motion to be accorded an earlier constructive reduction to practice.

11 The granting of Notomi Motion 2 and Notomi Motion 4 is illustrative
12 of motions to take away earlier constructive reductions to practice accorded
13 when the interference was declared.

14 After constructive reductions to practice are "determined" during the
15 motions phase, the junior party (plaintiff) and the senior party (defendant)
16 become fixed for the priority phase.

17 The junior party is presumed to be the second to invent and therefore
18 has the burden of establish priority earlier than the date accorded to the
19 senior party. 37 C.F.R. § 41.207(a) (2007).

20 The interference then moves to the priority phase where the parties
21 present their cases on the issue of priority.

22 After priority is determined, a final judgment is entered.

23 The consequences to the parties of a final judgment are set out in
24 35 U.S.C. § 135(a) and 37 C.F.R. § 41.127(a) (2007).

25 4.

26 Contested motions filed during the motions phase are almost always
27 decided by a panel of three judges and therefore are a decision of the Board.

1 Decisions of 3-judge panels at the motions phase are interlocutory
2 orders, but merge with a final judgment and are subject to judicial review
3 along with any final order.

4 A three-judge motions panel's decision in the motions phase is treated
5 by a three-judge merits panel (whether the same or a different panel) in the
6 priority phase under principles analogous to those governing the "law of the
7 case" albeit no "appeal" has taken place. *Cf.* (1) *Christianson v. Colt*
8 *Industries Operating Corp.*, 486 U.S. 800, 817 (1988) (the law of the case
9 doctrine merely expresses the practice of courts generally to refuse to reopen
10 what has been decided, not a limit to their power, citing *Messinger v.*
11 *Anderson*, 225 U.S. 436, 444 (1912)), and (2) *E-Pass Technologies, Inc. v.*
12 *3COM Corp.*, 473 F.3d 1213, 1217 (Fed. Cir. 2007) (once a case has been
13 decided on appeal, the rule adopted is to be applied, right or wrong, absent
14 exceptional circumstances, in the disposition of the law suit).

15 Our practice is that once an issue has been decided by a motions panel
16 during the motions phase, a decision is applied during the priority phase by a
17 priority merits panel absent exceptional circumstances.

18 As will become apparent, those circumstances are not present here.

19 A request for rehearing (filed within 14 days) can be sought of a
20 decision by a motions panel.

21 If rehearing is sought, as it was in this case by Rabbani, then any
22 decision on rehearing is interlocutory, but merges with the final judgment.

23 One caveat may be in order: only decisions by three-judge panels
24 merge with the final judgment, because a decision of a single judge is not a
25 decision of the Board.

26 Only a final judgment is subject to judicial review. *Cf. Copelands'*
27 *Enterprises, Inc. v. CNV, Inc.*, 887 F.2d 1065 (Fed. Cir. 1989) (*en banc*).

At this priority phase of this interference, absent some exceptional circumstance, it is not the function of this merits panel (Judges McKelvey, Torczon and Moore) to re-visit and again reconsider the decision of the motions panel (Judges McKelvey, Hanlon and Spiegel), adhered to on reconsideration, granting Notomi Motion 2 and Notomi Motion 4.

The facts belie the existence of any exceptional circumstance in this case.

We decline to resolve on its merits Rabbani's factual contention that certain events relevant to issues raised during motions phase "inherently" take place.

Maybe they do and maybe they do not, but Notomi tells us through its witness Dr. Jones that they do not. Oral argument transcript, page 33:10-14; page 38:15-19; and page 43:17-25.

The point is that the Donegan notebooks presumably were always in the possession of Rabbani and its real party in interest Enzo.

Not only where the notebooks in the possession of Rabbani and Enzo, but manifestly should have been reviewed prior to filing motions because when motions are filed, a party also has to file a priority statement.

The priority statement alleges the dates of invention. 37 C.F.R. § 41.204(a) (2007).

Dates of invention cannot be alleged if relevant priority evidence is not gathered and reviewed.

Rabbani apparently believes that the Donegan notebooks are relevant to the issue of priority—otherwise Rabbani would not be relying on those notebooks at this time.

1 Last, it is hard to overlook the fact that in proposing counts, Rabbani
2 urged "inherency" so it cannot be said that Rabbani was not aware of a need
3 to address the issue, particularly when its proposed count was not adopted.

4 Consistent with the law of the case analogy discussed above, when
5 new evidence is presented belatedly during the priority phase concerning a
6 matter decided during the motions phase, a party should not be allowed to
7 belatedly rely on evidence to seek to set aside a decision made during the
8 motions phase when that evidence was within the knowledge of and readily
9 available to the party at the time motions were filed during the motions
10 phase. *Cf. Kirschke v. Lamar*, 300 F.Supp. 146, 152-153 (W.D. Mo. 1969),
11 *aff'd*, 426 F.2d 870, 872 (8th Cir. 1970). *See also* 37 C.F.R. § 41.4(b)(2)
12 (2007) relating to "late filings."

13 It has been observed that delays in resolution of interferences in the
14 PTO "are notorious." *Medimmune, Inc. v. Genentech, Inc.*, 427 F.3d 958,
15 966 (Fed. Cir. 2005).

16 Apart from observations by courts, including our reviewing court,
17 delay in resolving interferences is a concern within the Patent and
18 Trademark Office.

19 Since 1998, when the Chief Administrative Patent Judge created
20 within the Board, the trial division to handle interferences, the Patent and
21 Trademark Office has been able to complete the vast majority of
22 interferences within the two year period codified by the Director in his
23 regulations. 37 C.F.R. § 41.200(c) (2007), *recodifying* 37 C.F.R. § 1.610(c)
24 (1985).

25 While this case is taking slightly longer than the 2-year goal, there is
26 no reason to prolong this case before the agency on the basis of the alleged

1 discovery of evidence which was in the possession of Rabbani and Enzo and
2 which was highly relevant to formulation of a priority statement.

3 A motions panel cannot err of the basis of evidence not timely
4 presented to it. *Cf. Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386,
5 1388 (Fed. Cir. 1989) (Markey) (prescience is not a required characteristic
6 of the board and the board need not divine all possible afterthoughts of
7 counsel that might be asserted for the first time on appeal).

8 IV.

9 A.

10 Notomi Motion 3 seeks to exclude Rabbani's priority evidence as
11 being not relevant under Fed. R. Evid. 402.

12 While filing an objection to the admissibility of priority evidence
13 based on possible suppression or concealment cannot be said to be wrong,
14 we believe there is a more administratively efficient way to raise a
15 suppression or concealment issue.

16 After a moving party's case-in-chief on priority (motion for judgment
17 and evidence) is served, as part of its opposition, an opponent may raise an
18 issue of suppression or concealment.

19 Raising suppression or concealment in an opposition is consistent the
20 proposition that the opponent, not the movant, has the burden of proof on
21 suppression or concealment.

22 The moving party can then reply, with or without evidence.

23 Since the opponent has the burden of proof on suppression or
24 concealment, it generally will be appropriate to exercise discretion to permit
25 the opponent to file a further reply, particularly where the moving party's
26 reply offers rebuttal evidence.

1 Notomi Motion 3 is granted only to the extent it seeks to exclude
2 Rabbani's priority evidence as a result of Rabbani's suppression or
3 concealment of its actual reduction to practice.

4 Notomi Motion 3 stands or falls with our decision Rabbani Motion 4.

5 B.

6 Notomi also seeks to exclude specific priority evidence independently
7 of suppression or concealment.

8 Specifically, Notomi seeks to exclude parts of Ex 1076—the direct
9 testimony of Mr. Fedus.

10 We have given essentially no weight to the Fedus testimony since it is
11 neither helpful nor credible.

12 Accordingly, we see no further reason to discuss its admissibility.

13 To the extent that the Notomi Motion 3 has not otherwise been
14 granted, it is *dismissed* as moot.

15 V.

16 Because Rabbani suppressed or concealed its 04 February 1998
17 assumed actual reduction to practice, it cannot prevail on priority.

18 Rabbani Motion 4 is *denied*.

19 Notomi Motion 6 is *granted*.

20 **D. Rabbani request for rehearing**

21 Rabbani requests rehearing of a decision entered by a motions panel
22 (Judges McKelvey, Torczon and Moore) denying Rabbani's motion *in*
23 *limine*.

24 In its motion *in limine*, Rabbani sought leave to present declaration
25 evidence as part of its reply.

26 Notomi opposed.

27 The motions panel denied the motion.

1 The motion did not seek leave to file declaration testimony related to
2 suppression or concealment.

3 Rather, the motion sought leave to file declaration testimony related to
4 Rabbani's alleged actual reduction to practice.

5 Since granting the request for rehearing would not result in any
6 additional meaningful evidence being presented on the issue of suppression
7 or concealment, the request for rehearing is dismissed as moot.

8 **E. Rabbani Motion 1**

9 Rabbani Motion 1 seeks to have non-involved Notomi claims
10 designated as corresponding to the counts.

11 The reason Rabbani would want Notomi claims designated as
12 corresponding to the counts is that if Rabbani had won on the issue of
13 priority and had Notomi claims been designated as corresponding to the
14 counts, then Notomi would not be entitled to those claims. 35 U.S.C.
15 § 135(a).

16 Since Rabbani has not prevailed on priority, there is no occasion to
17 consider whether additional Notomi claims should be designated as
18 corresponding to the counts.

19 Rabbani Motion 1 is *dismissed* as moot.

20 **F. Rabbani Motion 2**

21 Rabbani Motion 2 seeks to substitute a Count 3 for Count 1 and
22 Count 2.

23 When more than one count is involved in an interference, a
24 presumption exists that the subject matter of each count is separately
25 patentable from the subject matter of every other count. *See* 37 C.F.R.
26 § 41.201 (2007) (definition of "count").

1 As a result, to prevail on all counts, a party must establish priority
2 with evidence within the scope of each count.

3 In this case, Rabbani asserts that the subject matter of Count 1 is not
4 patentably distinct from the subject matter of Count 2 and therefore there
5 should be one count.

6 However, since Rabbani has not prevailed on the issue of priority as
7 to either count, there is no occasion to consider the question of whether the
8 subject matter of Count 1 is patentably distinct from the subject matter of
9 Count 2.

10 Rabbani Motion 2 is *dismissed* as moot.

11 **G. Notomi Motion to Exclude**

12 Since none of the evidence sought to be excluded by Notomi Motion
13 to Exclude is related to suppression or concealment on the part of Rabbani,
14 the motion is *dismissed* as moot.

15 **H. Order**

16 For the reasons given in this MEMORANDUM OPINION and
17 ORDER, it is

18 ORDERED that Rabbani Motion 1 seeking to designate Notomi
19 claims as corresponding to the counts is *dismissed* as moot.

20 FURTHER ORDERED that Rabbani Motion 2 seeking to
21 substitute Count 3 for Counts 1 and 2 is *dismissed* as moot.

22 FURTHER ORDERED that Rabbani Motion 4 for judgment
23 based on priority is *denied*. 35 U.S.C. § 102(g)(1).

24 FURTHER ORDERED that the Rabbani Request for Rehearing
25 is *dismissed* as moot.

26 FURTHER ORDERED that Notomi Motion 3 is *granted-in-*
27 *part* and *dismissed-in-part*.

1 FURTHER ORDERED that Notomi Motion 6 based on priority
2 is *granted*.

3 FURTHER ORDERED that Notomi Motion to Exclude is
4 *dismissed* as moot.

5 FURTHER ORDERED that a judgment in Interference 105,427
6 is entered concurrently herewith. Paper 161.

7 FURTHER ORDERED that a judgment in Interference 105,432
8 is entered concurrently herewith. Paper 161.

9 FURTHER ORDERED that a copy of this MEMORANDUM
10 OPINION and ORDER shall be entered in the files of (1) Rabbani
11 application 10/306,990, (2) Notomi patent 6,410,278 B1 and (3) Notomi
12 patent 6,974,670 B2.

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